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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,184	12/28/2001	George Y. Daniloff	2232-162	6428

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EXAMINER

GITOMER, RALPH J

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 08/27/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,184

Applicant(s)

DANILOFF ET AL.

Examiner

Ralph Gitomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 19-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Applicant's election without traverse of Group I, claims 1-18 in Paper No. 8 is acknowledged.

The present application is related to 10/029,184, pending, that was restricted and the elected claims 1-18 differ from the present application only in additional compounds claimed in the present application in claim 18. This application is a CIP of 09/754,217, pending, in which a compound was elected and an art rejection of that compound made. Priority is claimed to 2/21/2001 for the present application. Please inform the examiner as to how each application differs regarding the presently claimed subject matter to properly determine the correct priority date. At this time priority is granted only to the filing date of this application, 12/28/2001.

It is suggested that structures be provided of any particularly desired compounds to be claimed, such as those of claim 18, due to the complexity and inconsistency of naming such compounds.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-17 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-18 of prior U.S. Patent No. 10/187,903. This is a double patenting rejection.

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Claims 1-17 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-16 of prior U.S. Patent No. 09/754,217. This is a double patenting rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by James.

James (5,503,770) entitled “Fluorescent Compound Suitable for Use in the Detection of Saccharides” teaches in column 1 lines 48+ and column 5 lines 12+, fluorescent compounds for the detection of monosaccharides including glucose in aqueous solutions. James specifically recites a compound in which the R is anthracene, hydrogen, dimethylamine, boronic acid, alkyl groups and Z is carbon in column 4, compounds 9 and 10. James further discloses that the compounds may be attached to a supporting material in column 3 lines 37-47. Two boronic acid groups bind to the hydroxy groups of glucose in column 5 lines 21-24. James teaches that the compound contains a fluorophore that is quenched by an unshared electron pair on the nitrogen atom in column 2 lines 59-63. The compounds may be utilized to detect glucose inside the body by utilizing an optical fiber in column 5 lines 54-63.

All the features of the claims are taught by James for the same function as claimed.

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Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bell.

Bell (6,366,793) entitled "Minimally Invasive Methods for Measuring Analytes In Vivo" teaches in column 4 lines 20-23, diboronic acids for detecting glucose. Fluorescent compounds are taught in column 5. Various matrices are shown in columns 5-6 as well. In column 6 lines 27-34, the sensor may be implanted in the skin.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by DiCesare.

DiCesare (Anal Biochem) entitled "Evaluation of Two Synthetic Glucose Probes for Fluorescence Lifetime Based Sensing" teaches on page 155 Fig. 1 two boronic acid compounds for detecting glucose.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinkai.

Shinkai (Trends in Analytical Chemistry) entitled "Molecular Design of Artificial Sugar Sensing Systems" teaches on page 189 structure s 6 and 7 for detecting glucose.

All the features of the claims are taught by the above references for the same function as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 defines a compound in functional terminology only which is indefinite. In claim 2 and all occurrences, "capable of" is improper.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Daniel (5,516,645) teaches vanadium compounds.

Carpenter (6,511,814) teaches determining glucose.

Colvin (6,344,360) teaches detecting glucose with fluorescent compounds.

Goodman (5,998,594) teaches glucose substrates containing copper.

Arnold (6,063,637) teaches copper containing compounds for determining glucose.

Ullman (WO 99/46600) teaches fluorescent boronic acid compounds for glucose detection.

Arimori (Chemistry Letters) teaches boronic acid compounds for detecting glucose.

Daniloff (Diabetes Tech & Thera) teaches implantable glucose monitors.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (703) 308-0732. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (703) 308-1235. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Ralph Gitomer
Primary Examiner
Art Unit 1651

RALPH GITOMER
PRIMARY EXAMINER
GROUP 1200